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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/780,448

02/13/2004

Arturo A. Rodriguez

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05/03/2005

SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/780,448

Applicant(s)

RODRIGUEZ ET AL.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the provisional application (60/214,987) upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112. In particular, the provisional application generally discloses that the user may select a video program and may further receive an on-screen notification that a particular title will no longer be available for rent (Page 8 – Notifications). However, with respect to claims 1 and 5, it is unclear from the provision application that this reminder information is actually provided "responsive to associating the selected video presentation with [a] reminder list" as opposed to the user simply viewing the available programs for rent.
2. With respect to applicant's claim for priority as a continuation-in-part to co-pending application No. 09/590,488, the earlier application discloses the overall system architecture of the utilized by the instant application (Figures 1-3) and illustrates similar GUI screen-shots. The claimed subject matter of the independent claims of the instant application pertaining to the adding of a selected media title to a "reminder" list does not appear to be supported in the parent application. Accordingly, claims 1-8 of the instant application shall be examined in view of the filing date of the co-pending parent application (09/693,784) for which the instant application is a Divisional or 19 October 2000.

### ***Response to Arguments***

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3. Applicant's arguments filed 28 March 2005 have been fully considered but they are not persuasive. In particular the examiner respectfully disagrees that the LaJoie et al. reference fails to anticipate the newly amended claim as set forth in the grounds of rejection..

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by LaJoie et al. (US Pat No. 5,850,218).

In consideration of claims 1 and 5, Figure 3 of LaJoie et al. illustrates a “television set-top terminal” [6] comprising “memory configured to store program code” [32] and a “processor programmed by the program code” [30] so as to implement a “method” for providing program reminder information. As illustrated in Figure 29, the method comprises “providing a list of rentable presentations” [576] and “receiving viewer input configured to select configured to select one of the titles from the list of rentable video presentations” (Col. 31, Lines 33-49). Subsequently, “responsive to receiving the viewer input” and purchasing the event, the “selected rentable video presentation” is “associated . . . with a reminder list” reminding the viewer as to the particular events purchased [594] (Figure 31). Accordingly, “responsive to associating the selected video presentation with the reminder list”, as illustrated in Figure 31, the user may be provided with an event barker [544] or reminder

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information (Figures 28/30) subsequent to canceling the previously purchased event “while the selected rentable video presentation remains rentable . . . [reminding the user] of the expiring time for rentability of the selected rentable video presentation via the STT” or 8:15 PM in case the user would like to rent the movie again or watch a free preview.

For example, a user initially requests to rent “The Bridges of Madison County” starting at 8:00 PM. At a later point in time, the user accesses a form of “reminder list” reminding the user as to previous purchases whereupon the user changes their mind as to renting the particular movie. Upon returning to the “Now Showing” screen associated with the PPV channel, the user is “reminded” while the “The Bridges of Madison County” is playing that they must re-purchase the movie prior to the “expiration of rentability” for that particular showing or 8:15 PM if they would like to change their mind again and watch that particular presentation.

Claims 2 and 6 are rejected wherein the “step of providing reminder information is performed responsive to viewer input requesting access to the reminder list” (Figure 31).

Claims 3 and 7 are rejected wherein the “step of providing reminder information is performed responsive to viewer input requesting access to a list of presentations currently available for rent” such that the reminder information pertaining to the time frame in which the program is ordered is presented subsequent to the user ordering the presentation from a list of presentations currently available for rent as required by the first portion of claim 1.

Claims 4 and 8 are rejected wherein the “step of providing reminder information is performed via a barker” [544].

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:30 a.m. - 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access

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to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197  
(toll-free).

SEB

April 21, 2005



**JOHN MILLER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**